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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,635	01/27/2004	Steven E. Morton	ECSIX 104 DIV 2	2257

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KREMBLAS, FOSTER, PHILLIPS & POLLOCK
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REYNOLDSBURG, OH 43068

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/765,635	Applicant(s) MORTON, STEVEN E.	
	Examiner Alicia Chevalier	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39,40 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39,40 and 43-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>2/6/07</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

RESPONSE TO AMENDMENT

1. Claims 19, 40 and 43-45 are pending in the application, claims 1-28, 41 and 42 have been cancelled.
2. Amendments to the claims, filed on November 27, 2006, have been entered in the above-identified application.
3. It is noted that the current amendment filed November 27, 2006 is non-compliant in accordance with 37 CFR 1.121, because the status identifier on claim 43 is incorrect. The status identifier on claim 43 should be (new), since the last entered claim amendment, May 10, 2006, did not include claim 43. For purposes of examination, claim 43 is considered to have the status identifier (new) and the appropriate office action follows.

WITHDRAWN REJECTIONS

4. The 35 U.S.C. §102 rejection of claims 39 and 40 over Sweeney (US Patent No. 5,209,968), made of record in the office action mailed July 27, 2006, pages 3-4, paragraph #7 has been withdrawn due to Applicant's amendment in the response filed November 27, 2006.

REJECTIONS

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

6. Claims 39, 40 and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the instant case amended claim 39 contains the limitation, “a particulate layer ... is at least two particulate particles thick.” The specification does not disclose the thickness of the particulate layer, therefore this limitation is considered new matter. The only discussion in the specification of thickness is on page 11, lines 5-6, where it discusses the total thickness of the wear-resistant coating. The specification is also silent about the size of the particles or the matrix thickness above the fibers. Furthermore, the drawings do not support this limitation since figure 9 shows that the particle layer is discontinuous and sometimes not even show one particle thick.

The new matter must be deleted.

7. Claims 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the instant case amended claim 39 contains the limitation, “a particulate layer ... is between about one-eighth and about three quarters of one inch thick.” The specification does not

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disclose the thickness of the particulate layer, therefore this limitation is considered new matter. The only discussion in the specification of thickness is on page 11, lines 5-6, where it discusses the *total thickness of the wear-resistant coating*. The wear-resistant coating comprising the reinforcing fibers matrix layer and particle layer, page 5, lines 2-7. The specification is also silent about the size of the particles or the matrix thickness above the fibers. Furthermore, the drawings do not support this limitation since they are not drawn to scale.

The new matter must be deleted.

Claim Rejections - 35 USC § 102

8. Claims 39, 40 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagin (U.S. Patent No. 3,497,211).

Nagin discloses a modular flooring unit (*panels, col. 3, lines 17-18 and figure 1*). The unit comprises a planer polymer matrix (*col. 3, line 75 through col. 4, line 9*) formed from a polymer matrix material (*col. 3, line 75 through col. 4, line 9*), a reinforcing fiber layer (*glass fibers, col. 4, lines 9-11*), and a particulate layer (*col. 4, lines 45-47 and figures 6 and 7*). The reinforcing fibers are embedded in the matrix material for reinforcing the matrix (*col. 4, lines 9-11 and figures 6 and 7*). The particulate layer is mounted to a major surface of the layer reinforcing fibers and is at least two particulate particles thick and wherein the matrix material surrounds at least some of the particulate particles for mounting the particulate layer to the reinforcing fiber layer (*figures 6 and 7*). The particulate layer is sand (*col. 4, line 39*).

The unit is deemed to be a discrete size and weight that can be lifted by a human, because the reference that the panels or generally on the order of 4 to 8 feet and are preferably shorter for

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easier handling (*col. 3, line 42 and lines 65-66*), which is deemed capable of being lifted by a human.

The particulate layer mounted to the matrix is deemed to form a traffic-bearing surface of the flooring unit (*col. 4, lines 49-60*).

Claim Rejections - 35 USC § 103

9. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagin (U.S. Patent No. 3,497,211).

Nagin is relied upon as described above.

Nagin fails to disclose that the particulate layer is between about one-eighth and about three quarters of one inch thick.

The exact thickness of the particulate layer is deemed to be a result effective variable. It would require routine experimentation to determine the optimum value of a result effective variable, such as thickness, in the absence of a showing of criticality in the claimed thickness of the particulate layer. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to optimize the thickness of the particulate layer to an appropriate thickness to provide a sufficient number of irregularities to give the required thrust or braking effect (*col. 4, lines 50-53*).

ANSWERS TO APPLICANT'S ARGUMENTS

10. Applicant's arguments in the response filed November 27, 2006 regarding the 35 USC 102 rejection over Sweeney of record have been considered but are moot since the rejections have been withdrawn.

11. Applicant's arguments in the response filed November 27, 2006 regarding the 35 USC 112, first paragraph rejection of record have been carefully considered but are deemed unpersuasive.

Applicant repeatedly argues that figure 9 shows the limitation, "a particulate layer ... is at least two particulate particles thick." The examiner still maintains that she cannot distinguish the particles from the matrix. The drawing is unclear for supporting that particular limitation.

Applicant's representative further commented at the interview on Feb. 6, 2007 that the figures show that the particles vary in size. The examiner is also unable to find support in the specification for this explanation of the figures. The figures are not disclosed with sufficient specificity for the examiner to conclude much about the particles.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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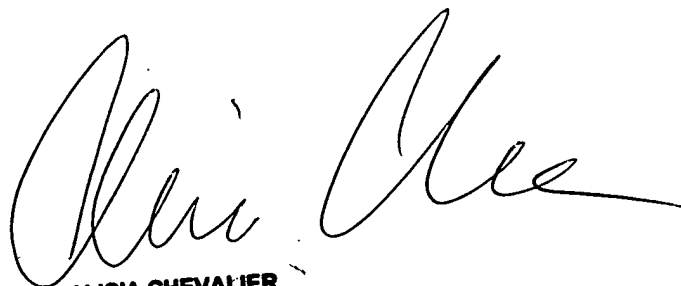
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
2/17/07


**ALICIA CHEVALIER
PRIMARY EXAMINER**